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# TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT

Docket Number (Optional)  
142-94 (D6384)

In re Application of: DiMaio et al.

Application No.: 09/637,791

Filed: August 11, 2000

For: PROCESS FOR PRODUCING LIQUID POLYALPHAOLEFIN POLYMER, METALLOCENE...

The owner\*, Crompton Corporation, of 100% percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,713,582. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

 11/5/2004  
Signature Date

Adrian T. Calderone, Reg. No. 31,746

Typed or printed name

516-228-8484

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0851-0032  
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**FEE TRANSMITTAL**  
**for FY 2004**

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ 110.00)**Complete if Known**

|                      |                 |
|----------------------|-----------------|
| Application Number   | 09/637,791      |
| Filing Date          | August 11, 2000 |
| First Named Inventor | DiMaio          |
| Examiner Name        |                 |
| Art Unit             |                 |
| Attorney Docket No.  | 142-94 (D6384)  |

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

|                        |                        |
|------------------------|------------------------|
| Deposit Account Number | 04-1121                |
| Deposit Account Name   | Dilworth & Barrese LLP |

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) during the pendency of this application  
☒ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.
**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description        | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 1001 790                   | 2001 395                   | Utility filing fee     |          |
| 1002 350                   | 2002 175                   | Design filing fee      |          |
| 1003 550                   | 2003 275                   | Plant filing fee       |          |
| 1004 790                   | 2004 395                   | Reissue filing fee     |          |
| 1005 160                   | 2005 80                    | Provisional filing fee |          |

**SUBTOTAL (1)** (\$ 0.00)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims       | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| Independent Claims | -20** =      | X              | 0.00     |
| Multiple Dependent | -3** =       | X              | 0.00     |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  |
|----------------------------|----------------------------|--|
| 1202 18                    | 2202 9                     | Claims in excess of 20                                     |
| 1201 88                    | 2201 44                    | Independent claims in excess of 9                          |
| 1203 300                   | 2203 150                   | Multiple dependent claim, if not paid                      |
| 1204 88                    | 2204 43                    | ** Reissue independent claims over original patent         |
| 1205 18                    | 2205 9                     | ** Reissue claims in excess of 20 and over original patent |

**SUBTOTAL (2)** (\$ 0.00)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1051 130                   | 2051 65                    | Surcharge - late filing fee or oath  |          |
| 1052 50                    | 2052 25                    | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053 130                   | 2053 65                    | Non-English specification  |          |
| 1812 2,520                 | 1812 2,520                 | For filing a request for ex parte reexamination                            |          |
| 1804 920*                  | 1804 920*                  | Requesting publication of SIR prior to Examiner action                     |          |
| 1806 1,840*                | 1806 1,840*                | Requesting publication of SIR after Examiner action                        |          |
| 1251 110                   | 2251 55                    | Extension for reply within first month                                     |          |
| 1252 430                   | 2252 215                   | Extension for reply within second month                                    |          |
| 1253 980                   | 2253 490                   | Extension for reply within third month                                     |          |
| 1254 1,530                 | 2254 765                   | Extension for reply within fourth month                                    |          |
| 1255 2,060                 | 2255 1,040                 | Extension for reply within fifth month                                     |          |
| 1401 340                   | 2401 170                   | Notice of Appeal   |          |
| 1402 340                   | 2402 170                   | Filing a brief in support of an appeal                                     |          |
| 1403 300                   | 2403 150                   | Request for oral hearing   |          |
| 1451 1,510                 | 2451 1,510                 | Petition to institute a public use proceeding                              |          |
| 1452 110                   | 2452 55                    | Petition to revive - unavoidable   |          |
| 1453 1,370                 | 2453 685                   | Petition to revive - unintentional   |          |
| 1601 1,370                 | 2501 685                   | Utility issue fee (or reissue)   |          |
| 1602 490                   | 2502 245                   | Design issue fee   |          |
| 1603 660                   | 2503 330                   | Plant issue fee  |          |
| 1460 130                   | 2460 130                   | Petitions to the Commissioner  |          |
| 1807 50                    | 2807 50                    | Processing fee under 37 CFR 1.17(q)  |          |
| 1806 180                   | 2806 180                   | Submission of Information Disclosure Stmt                                  |          |
| 8021 40                    | 28021 40                   | Recording each patent assignment per property (times number of properties) |          |
| 1809 790                   | 2809 395                   | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810 790                   | 2810 395                   | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801 790                   | 2801 395                   | Request for Continued Examination (RCE)                                    |          |
| 1802 900                   | 2802 900                   | Request for expedited examination of a design application                  |          |

Other fee (specify) Terminal Disclaimer

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$ 110.00)**SUBMITTED BY**

|                   |                            |                                   |                  |           |                |
|-------------------|----------------------------|-----------------------------------|------------------|-----------|----------------|
| Name (Print/Type) | Adrian T. Calderone        | Registration No. (Attorney/Agent) | 31,746           | Telephone | (516) 228-8484 |
| Signature         | <i>Adrian T. Calderone</i> | Date                              | November 5, 2004 |           |                |

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (Fax No.: 703-872-9306) on the date shown below.

Date: November 5, 2004

*Maria Goldman*  
Maria Goldman